Atty. Ref. No. <u>3382-59319</u>
Application Number 09/898,702

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Slavka et al.

Application No. 09/898,702

Filed: July 2, 2001

Confirmation No. 4420

For: DISTRIBUTING SOFTWARE VIA
DISTRIBUTION FILES (AS AMENDED)

Examiner: Robert B. Harrell

Art Unit: 2142

Attorney Reference No. 3382-59319

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APPEAL BRIEF

This brief is in furtherance of the Notice of Appeal dated November 25, 2003, and
received November 28, 2003. The fee required under 37 C.F.R. § 1.17(c) is enclosed.

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I.   REAL PARTY IN INTEREST

The real party in interest is Microsoft Corporation, by an assignment from the inventors

recorded at Reel 011968, Frames 0595 *et seq.* Microsoft Corporation is a Washington

corporation having a place of business at One Microsoft Way, Redmond, Washington, 98052.

II.   RELATED APPEALS AND INTERFERENCES

No other appeals or interferences relate to the present application.

III.   STATUS OF CLAIMS

Claims 1-56 are in the application, of which claims 28-35 and 37-56 are currently

pending. Claims 1-27 and 36 were previously canceled. Claims 28-35 and 37-56 stand rejected.

The claims on appeal are: 28-35 and 37-56.

IV.   STATUS OF AMENDMENTS

All amendments have been entered.

V.   SUMMARY OF THE INVENTION

The claims include those directed to a computer-executable distribution file comprising

software installable at the computer, an installation program, and installation program starting

instructions arranged within the distribution file to be automatically executed responsive to

execution of the distribution file. [*See, e.g.*, Application at pages 19-24.] For example, the

Application describes combining a cabinet file (which contains software to be installed) with a

self-extracting application program called "WEXTRACT.EXE" to create a self-extracting

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executable archive file. [*See* Application at page 23, lines 10-12; FIG. 7 at reference numeral

134.] In this example, the combining of the cabinet file and WEXTRACT program is performed

by a utility called "COMBINE.EXE". [*See* Application at page 23, lines 13-18.] In an example

described at page 27, the Application states, "the extractor in the self-extracting executable

distribution file (e.g., WEXTRACT) extracts and decompresses . . . the files in the cabinet file,

and automatically starts the installation program (if any) that was specified (e.g., setup.exe

/RUN) when the cabinet file was created." [*See* Application at page 27, lines 26-30.] One

possible advantage of such an approach is that software to be installed is contained *in the same*

file with an installation program and installation program starting instructions for the

convenience of the user.

VI.   ISSUES

A. Whether the Office met its burden of establishing that claims 28-35, 37-38, 46, and 53

are anticipated by Fawcett under 35 U.S.C. 102(e).

B. Whether the Office met its burden of establishing that claims 39-45, 47-52, and 54-56

are anticipated by Fawcett under 35 U.S.C. 102(e).

VII.   GROUPING OF CLAIMS

For reasons detailed below, each of the independent claims 28, 30, 32, 33, 34, 35, 37, 38,

39, 46, 47, 53, 54, and 55 is independently patentable. The dependent claims each contain

limitations that further distinguish over the art of record. However, since the limitations of the

independent claims are sufficient to distinguish this art, and to facilitate the Board's

consideration of this appeal, Applicants group the claims for purposes of this appeal as follows:

The patentability of claims 28-29, 31-35, 37-38, 46, and 53 stands or falls with the patentability of claim 30.

The patentability of claims 40-45, 47-52, and 54-56 stands or falls with the patentability of claim 39.

VIII. ARGUMENT

A. The Cited Art: U.S. Patent 5,845,077 to Fawcett ("Fawcett")

Fawcett describes an "update service computer." [*See* Fawcett at abstract.] "The update service automatically inventories the user computer to determine what computer software may be out-of-date, and/or need maintenance updates. If so desired by the user, the update service computer automatically downloads and installs computer software to the user computer." [*See* Fawcett at abstract.] For example, Fawcett describes an arrangement where a user can choose to have software automatically installed by the update service when the update service re-connects to the user computer. [*See* Fawcett at col. 10, lines 1-4.] Fawcett also describes an arrangement where a user can choose to install software at a particular time by launching an installation application supplied by the update service computer. [*See* Fawcett at col. 9, lines 47-63.]

Fawcett does not describe a *single file* that contains installable software, an installation application, and installation application starting instructions. Neither does Fawcett describe that the installation application is at a location within the file so as to be automatically *executed responsive to execution of the file.*

B.   Rejection of Claims 28-35, 37-38, 46, and 53 Under 35 U.S.C. § 102(e)

1.   Independent Claim 30

Fawcett's description of automatic installation of software does not teach or suggest a single file comprising software, an installation program, and installation program starting instructions *arranged within the file to be automatically executed responsive to execution of the file.*

Claim 30 is directed to a computer-executable distribution file comprising software installable at the computer, an installation program, and installation program starting instructions arranged within the distribution file to be automatically executed responsive to execution of the distribution file. [*See, e.g.*, Application at pages 19-24.] Claim 30 recites:

> A computer-readable storage medium having a computer-executable distribution file for distributing software to a computer and installing the software on the computer upon execution of the distribution file, the distribution file comprising:
> software installable at the computer;
> an installation program co-resident in the distribution file with the software, the installation program operable to install the software; and
> executable installation program starting instructions arranged within the distribution file to be automatically executed responsive to execution of the distribution file, the installation program starting instructions operable to start the installation program to install the software.

The Application provides several examples of computer-executable distribution files.

For example, the Application describes combining a cabinet file (which contains software to be installed) with a self-extracting application program called "WEXTRACT.EXE" to create a self-extracting executable archive file. [*See* Application at page 23, lines 10-12; FIG. 7 at reference numeral 134.]

Fawcett discusses different ways to install software, but does *not* describe installation program starting instructions in the same file as the software. Specifically Fawcett states:

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> After establishing a new two-way communications path, the user update application creates a new directory (104) on the user computer, where the computer software is transferred and stored (106). A log is also created to document what available computer software was transferred to the user computer. *Included with* the downloaded computer software is an installation application that will be used later by the user to install the computer software. When the transfers are complete, the update service computer terminates the connection to the user computer (108). An encryption scheme may also be used to permit safe automated transfer of the software to the user computer.
>
> When the user is ready to install the computer software (e.g. the next morning if the computer software was transferred and installed in the middle of the night), the user simply launches the installation application supplied by update service computer.
>
> Leaving the user an installation application to execute is an added safety and security measure for both the user and the update service. The user computer is not updated unless the user personally starts the installation process. However, the user can also choose to have the computer software automatically installed by the update service when it re-connects to the user computer (but, user permission is always obtained and recorded first). In this case, the installation application is not downloaded to the user computer.

[*See* Fawcett at col. 9, line 47 – col. 10, line 5, emphasis added.] Thus, Fawcett does describe an installation application "[i]ncluded with the downloaded computer software."

Fawcett's passages describing "included with" do not describe installation program starting instructions in the same file as the software. Section 102(e) requires that the reference teach every element of the claim. Claim 30 recites that a file comprises software and "installation program starting instructions arranged within the distribution file." The above passage in Fawcett that describes including an installation program with the software does not describe that *installation program starting instructions* and the software are in the same file. In fact, Applicants cannot find any description of installation program starting instructions in any file anywhere in Fawcett. Accordingly, the Office relies on what can best be described as an inherency argument.

The arrangement in Fawcett does not inherently describe installation program starting instructions in the same file as the software. Even though Fawcett does not describe what is

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claimed, the Office can still rely on a rejection based on inherency. For an inherency rejection, however, the missing descriptive matter must be *necessarily* present in what is described in the reference. *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1377 __ USPQ2d __, __ (Fed. Cir. 2003).

The Office does not present any evidence that the claimed arrangement must necessarily be present in Fawcett. The Action of June 25, 2003, states:

> [T]he service update application that installs the software on the user computer is located on the update service computer. However, since Fawcett fails to teach the service update computer had direct access to the user's hard disk (e.g., via FTP for example) to directly transfer the required components onto the hard disk, it was anticipated that the service update computer transmitted an installation application along with the software . . .

Later, an Interview Summary of December 9, 2003, states:

> Col. 10 (lines 4-7) [of Fawcett] states the installation application is not downloaded as stated in col. 9 (lines 64, et seq.). Thus examiner asserts the installation application is a part of the software filed [sic] downloaded or on CD-ROM.

Thus, the Office has concluded that, based on the passage in Fawcett, an installation application must be part of the software file downloaded in Fawcett.

Applicants disagree with the conclusion; it does not follow from the Examiner's observations that an installation application must necessarily be *in the same file* as the software to be installed. But, more importantly, even if the installation application were in the same file as the software, it still does not follow that *installation program starting instructions* must necessarily be in the same file as the software. The Office thus far has not argued or presented evidence that such instructions necessarily must be in the same file as the software. Fawcett does not describe such instructions, and it would not need them to operate. For example, Fawcett's described user update application could start a software installation application.

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Therefore, not only does Fawcett fail to describe the claimed arrangement, but it also does not follow that what Fawcett describes necessarily would include the claimed arrangement. For at least these reasons, claim 30 overcomes the 102(e) rejection, and the rejection should be reversed.

2. Independent Claim 28

Claim 28 recites "placing instructions for automatically invoking the instructions for installing the software in the file" and is therefore allowable at least for reasons similar to those stated for claim 30.

3. Independent Claim 32

Claim 32 recites "executable installation program starting instructions arranged within the distribution file" and is therefore allowable at least for reasons similar to those stated for claim 30.

4. Independent Claim 33

Claim 33 recites "executable installation program starting instructions arranged within the distribution file" and is therefore allowable at least for reasons similar to those stated for claim 30.

5. Independent Claim 34

Claim 34 recites "installer starting instructions arranged within the distribution file" and is therefore allowable at least for reasons similar to those stated for claim 30.

6. Independent Claim 35

Claim 35 recites "executable installation program starting instructions arranged within the distribution file" and is therefore allowable at least for reasons similar to those stated for claim 30.

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7. Independent Claim 37

Claim 37 recites "wherein the software distribution file further comprises means for initiating the installation program" and is therefore allowable at least for reasons similar to those stated for claim 30.

8. Independent Claim 38

Claim 38 recites "executable installation starting means arranged within the distribution file" and is therefore allowable at least for reasons similar to those stated for claim 30.

9. Independent Claim 46

Claim 46 recites "placing, at a location within the file . . . , instructions for automatically invoking the instructions for installing the software in the file" and is therefore allowable at least for reasons similar to those stated for claim 30.

10. Independent Claim 53

Claim 53 recites "installer starting instructions arranged within the distribution file" and is therefore allowable at least for reasons similar to those stated for claim 30.

For the sake of brevity, Applicants do not present separate arguments for all the dependent claims, which are allowable at least because their associated independent claims are allowable.

For at least these reasons, the final rejection of claims 28-35, 37-38, 46, and 53 should be reversed.

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C. Rejection of Claims 39-45, 47-52, and 54-56 Under 35 U.S.C. § 102(e)

1. Independent Claim 39

Fawcett's description of automatic installation of software does not teach or suggest a file comprising software and instructions for installing the software at a location within the file so as to be automatically executed responsive to execution of the file.

Claim 39 is directed to a method of building a file for installing software, the method comprising placing the software in the file and placing instructions for installing the software in the file. [*See, e.g.*, Application at pages 19-24.] Claim 39 recites:

> A method of building a file for installing software at a remote computer, the method comprising:
>> placing the software in the file; and
>> placing, at a location within the file so as to be automatically executed responsive to execution of the file, instructions for installing the software on the remote computer.

As described above, Fawcett discusses different ways to install software at col. 9, line 47 – col. 10, line 5. Thus, Fawcett does describe an installation application "[i]ncluded with the downloaded computer software."

Fawcett's passages describing "included with" do not describe that installation program starting instructions are placed within a file so as to be automatically executed responsive to execution of the file. Section 102(e) requires that the reference teach every element of the claim. Claim 39 recites that a file comprises software and "instructions for installing the software" placed "at a location within the file so as to be automatically executed responsive to execution of the file." Fawcett's passage describing including an installation program with the software does not describe that the installation program is placed "at a location within the file so as to be automatically executed responsive to execution of the file." In fact, Applicants cannot find

where Fawcett describes that the installation program is included in the file at all. Accordingly, the Office relies on what can best be described as an inherency argument.

The arrangement in Fawcett does not inherently describe an installation program placed at a location within a file so as to be automatically executed responsive to execution of the file. The Action does not present any evidence that the claimed arrangement necessarily is present in Fawcett. The Action of June 25, 2003, states:

> The service update application that installs the software on the user computer is located on the update service computer. However, since Fawcett fails to teach the service update computer had direct access to the user's hard disk (e.g., via FTP for example) to directly transfer the required components onto the hard disk, it was anticipated that the service update computer transmitted an installation application along with the software . . .

Later, an Interview Summary of December 9, 2003, states:

> Col. 10 (lines 4-7) [of Fawcett] states the installation application is not downloaded as stated in col. 9 (lines 64, et seq.). Thus examiner asserts the installation application is a part of the software filed [sic] downloaded or on CD-ROM.

Thus, the Office has concluded that, based on the passage in Fawcett, an installation application must be part of the software file downloaded in Fawcett.

Applicants disagree with the conclusion. But, more importantly, even if the installation application were in the same file as the software, it still does not follow that *it must necessarily be placed in the file so as to be automatically executed responsive to execution of the file.* So far, the Office has not presented argument or evidence to so establish. Fawcett does not describe the placement of an installation application in a file or executing a file containing the software and instructions for installing the software. Moreover, Fawcett would not need to do so to operate. For example, Fawcett's described user update application could start a software installation application (e.g., without executing a file comprising the software and the software installation

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program); so the installation application would not be automatically executed responsive to execution of the file.

Therefore, not only does Fawcett fail to describe the claimed arrangement, but it also does not follow that what Fawcett describes would necessarily include the claimed arrangement. For at least these reasons, claim 39 overcomes the 102(e) rejection, and the rejection should be reversed.

2.   Independent Claim 47

Claim 47 recites "the installation program operable to install the software and arranged within the distribution file to automatically install the software upon execution of the distribution file" and is therefore allowable at least for reasons similar to those stated for claim 39.

3.   Independent Claim 54

Claim 54 recites "the installer operable to install the software and arranged within the distribution file to be automatically executed responsive to execution of the distribution file" and is therefore allowable at least for reasons similar to those stated for claim 39.

4.   Independent Claim 55

Claim 55 recites "code for extracting and installing the software . . . , the code arranged within the distribution file to be automatically executed upon execution of the distribution file" and is therefore allowable at least for reasons similar to those stated for claim 39.

For the sake of brevity, Applicants do not present separate arguments for all the dependent claims, which are allowable at least because their associated independent claims are allowable.
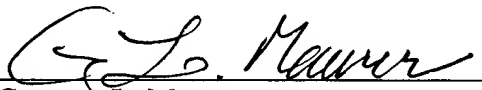
For at least these reasons, the final rejection of claims 39-45, 47-52, and 54-56 should be reversed.

IX.   CONCLUSION

The Final Rejection failed to establish that Fawcett anticipates claims 28-35 and 37-56, as required for a § 102(e) rejection. Accordingly, the rejection of these claims should be reversed and all claims passed to issue.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By _____
Gregory L. Maurer
Registration No. 43,781

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 226-7391
Facsimile: (503) 228-9446

APPENDIX A

CLAIMS ON APPEAL

28.   A method of providing a file for installing desired software at a remote computer, the method comprising:

placing the desired software in the file;

placing instructions for installing the software in the file;

placing instructions for automatically invoking the instructions for installing the software in the file; and

placing the file in a location accessible to the remote computer via a computer network;

whereby, when the file is retrieved and opened by the remote computer, the instructions for installing the software are automatically invoked to install the desired software.

29.   The method of claim 28 further comprising:

over the computer network, providing to the remote computer a reference to the location accessible to the remote computer via the computer network.

30.   A computer-readable storage medium having a computer-executable distribution file for distributing software to a computer and installing the software on the computer upon execution of the distribution file, the distribution file comprising:

software installable at the computer;

an installation program co-resident in the distribution file with the software, the installation program operable to install the software; and

executable installation program starting instructions arranged within the distribution file

to be automatically executed responsive to execution of the distribution file, the installation

program starting instructions operable to start the installation program to install the software.

31.   The computer-readable storage medium of claim 30 wherein the computer-

executable distribution file is an executable program.

32.   A computer-readable software program carrier medium having carried thereon a

computer-executable distribution file for distributing software to a computer and installing the

software on the computer upon execution of the distribution file, the distribution file comprising:

software installable at the computer;

an installation program co-resident in the distribution file with the software, the

installation program operable to install the software; and

executable installation program starting instructions arranged within the distribution file

to be automatically executed responsive to execution of the distribution file, the installation

program starting instructions operable to start the installation program to install the software.

33.   A computer-readable storage medium having a computer-executable distribution

file for distributing and installing software on a computer upon execution of the distribution file,

the distribution file comprising:

software installable at the computer;

an installation program co-resident in the distribution file with the software, the

installation program operable to install the software; and

executable installation program starting instructions arranged within the distribution file

to be automatically executed responsive to execution of the distribution file, the installation

program starting instructions operable to start the installation program to install the software.

34.   A computer-readable storage medium having a distribution file for distributing

and installing software on a computer, the distribution file comprising:

software installable at the computer;

an installer co-resident in the distribution file with the software, the installer operable to

install the software;

an extractor co-resident in the distribution file with the software, the extractor operable to

extract the software and the installer from the distribution file and automatically invoked upon

receipt of the distribution file; and

installer starting instructions arranged within the distribution file to be automatically

executed upon completion of extraction of the software and the installer, the installer starting

instructions operable to start the installer to install the software.

35.   A computer-readable storage medium having a computer-executable distribution

file for distributing and installing software on a computer upon execution of the distribution file,

the distribution file comprising:

software installable at the computer;

a set of installation instructions co-resident in the distribution file with the software, the

installation instructions operable to direct installation of the software; and

executable installation program starting instructions arranged within the distribution file

to be automatically executed responsive to execution of the distribution file, the installation

program starting instructions operable to start the installation instructions to direct installation of

the software.

37.   In a server computer in communication with a remote computer over a network, a

software system for installing software on the remote computer, the system comprising:

means for accepting an indication from a user at the remote computer that selected

software is to be installed on the remote computer;

responsive to the means for accepting, means for uploading a software distribution file to

the remote computer, wherein the software distribution file comprises the selected software and

an installation program for installing the selected software, wherein the software distribution file

further comprises means for initiating the installation program upon activation of the software

distribution file; and

means to indicate the distribution file is to be activated to install the selected software.

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38.   A computer-readable storage medium having a computer-executable distribution file for distributing and installing software on a computer upon execution of the distribution file, the distribution file comprising:

software installable at the computer;

installation means co-resident in the distribution file with the software, the installation means operable to install the software; and

executable installation starting means arranged within the distribution file to be automatically executed responsive to execution of the distribution file, the installation starting means operable to start the installation means to install the software.

39.   A method of building a file for installing software at a remote computer, the method comprising:

placing the software in the file; and

placing, at a location within the file so as to be automatically executed responsive to execution of the file, instructions for installing the software on the remote computer.

40.   The method of claim 39 further comprising:

combining the file with a digital signature of the file into a digitally-signed file.

41.   The method of claim 39 further comprising:

appending a digital signature of the file to the file.

42.   The method of claim 39 wherein the instructions for installing the software in the file comprise instructions for installing the software in appropriate directories.

43.   The method of claim 39 wherein the instructions for installing the software in the file comprise instructions for deleting files.

44.   The method of claim 39 wherein the instructions for installing the software in the file comprise instructions for updating files.

45.   A computer-readable medium comprising computer-executable instructions for performing the method of claim 39.

46.   A method of building a file for installing desired software at a remote computer, the method comprising:

placing the desired software in the file;

placing instructions for installing the software in the file;

placing, at a location within the file so as to be automatically executed upon execution of the file, instructions for automatically invoking the instructions for installing the software in the file.

47.   A computer-readable storage medium having a computer-executable distribution file for distributing software to a computer and installing the software on the computer upon execution of the distribution file, the distribution file comprising:

software installable at the computer; and

an installation program co-resident in the distribution file with the software, the installation program operable to install the software and arranged within the distribution file to automatically install the software upon execution of the distribution file.

48.   The computer-readable storage medium of claim 47 wherein the distribution file is combined with a digital signature of the distribution file into a digitally-signed file.

49.   The computer-readable storage medium of claim 47 wherein a digital signature of the distribution file is appended to the distribution file.

50.   The computer-readable storage medium of claim 47 wherein the installation program comprises instructions for installing the software in appropriate directories.

51.   The computer-readable storage medium of claim 47 wherein the installation program comprises instructions for deleting files.

52.   The computer-readable storage medium of claim 47 wherein the installation program comprises instructions for updating files.

53.   A computer-readable storage medium having a distribution file for distributing

and installing software on a computer, the distribution file comprising:

software installable at the computer;

an installer co-resident in the distribution file with the software, the installer operable to

install the software;

an extractor co-resident in the distribution file with the software, the extractor operable to

extract the software from the distribution file and automatically invoked upon execution of the

distribution file; and

installer starting instructions arranged within the distribution file to be automatically

executed upon completion of extraction of the software, the installer starting instructions

operable to start the installer to install the software.

54.   A computer-readable storage medium having a distribution file for distributing

and installing software on a computer, the distribution file comprising:

software installable at the computer;

an extractor co-resident in the distribution file with the software, the extractor operable to

extract the software from the distribution file and automatically invoked upon execution of the

distribution file to extract the software from the distribution file; and

an installer co-resident in the distribution file with the software, the installer operable to

install the software and arranged within the distribution file to be automatically executed

responsive to execution of the distribution file.

55.   A computer-readable storage medium having a distribution file for distributing

and installing software on a computer, the distribution file comprising:

software installable at the computer; and

code for extracting and installing the software installable at the computer, the code

arranged within the distribution file to be automatically executed upon execution of the

distribution file.

56.   A computer-readable medium having stored thereon a file built according to the

method of claim 39.